

REMARKS

Amendments to claims 18 and 28 are to correct typographical errors. Amendments to claim 1, 2, 29, and 34 are for the purpose of clarifying what Applicant regards as the invention. Amendment to claim 6 is to bring this claim into conformity with the language of its base claim. No new matter has been added.

I. OBJECTION TO THE DRAWINGS

The drawings stand objected to because reference character 120(2) in figures 4a-c and reference character 210(5) in figure 7 are not mentioned in the specification. Applicant respectfully notes that reference character 120(2) is recited on page 14, paragraph 38 of the specification. Reference character 210(5) of Figure 7 has been corrected to recite 120(5), which is mentioned on page 17, paragraph 43 of the specification.

II. CLAIM REJECTIONS UNDER U.S.C. § 102

Claims 1-3, 7, and 29 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,083,222 (Klein). Applicant respectfully notes that in order to sustain a rejection under §102, each element in the rejected claim must be found, either expressly or inherently, in the cited reference.

Claim 1

Claim 1 has been amended to recite a distal portion of the shaft being bendable to form a desired configuration, and *a proximal portion of the shaft being rigid*. Klein does not disclose or suggest such limitation. Rather, Klein discloses a catheter 10 having a catheter body 14 and a distal

tip 18 that is relatively more flexible than the body 14 (Column 4, lines 40-52 and figure 1). There is nothing in Klein that disclose or suggest a shaft having a rigid proximal portion. For at least the foregoing reason, claim 1 and its dependent claims, are believed allowable over Klein.

Claim 29

Claim 29 recites placing internal tissue *between jaws of a clamp assembly*. Klein does not disclose or suggest such limitation. Rather, Klein discloses pressing a set of opened members 30, 32 against a tissue that is not placed between the members 30, 32 (see Figure 4B). For at least the foregoing reason, claim 29 and its dependent claims are believed allowable over Klein.

III. CLAIM REJECTIONS UNDER U.S.C. § 103

Claims 1-5 and 7-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,483,562 (Schoolman) in view of U.S. Patent No. 6,152,923 (Ryan).

Claims 1 and 29

Claim 1 recites first and second electrodes on the first and second jaws, respectively. Claim 29 recites a clamp assembly carrying at least one electrode. According to the office action, it would have been allegedly obvious to combine the electrode(s) of Ryan with the clamp of Schoolman to form the resulting subject matter of claims 1 and 29. Applicant respectively traverses.

Applicant respectfully submits that the motivation to combine Schoolman and Ryan is not present. To establish a case of obviousness under 35 U.S.C. § 103, there must be some motivation to combine the teaching of the references. (M.P.E.P. 706.02(j)). Furthermore, the fact that the references can be combined or modified is not sufficient to establish prima facie obviousness. (M.P.E.P. 2143.01). Rather, the prior art must suggest the desirability of the claimed invention. (M.P.E.P. 2143.01). In this case, Schoolman teaches a bendable device that is lockable in a bent

configuration such that a user can use the device to hold an object in a certain manner. For example, column 1, lines 33-39 and 42-46 state:

Prior examples of such devices have not included the ability to rigidly retain the flexible shaft in a desired shape for accommodating these objectives. This is especially important as it allows the user more freedom of movement than non-locking shafts which have a tendency to continually deviate from a desired shape during the use thereof.

Therefore, the objects of the present invention are: to provide a locking flexible shaft device with distal end attachment which is capable of assuming a continuous range of flexed shapes and being selectively and rigidly locked therein. . .

On the other hand, Ryan teaches an ablation device for creating multiple seals so that a surgeon does not have to manipulate forceps. In particular, column 1, line 66 to column 2 line 12, and column 3, lines 4-7 state:

As mentioned above, electrosurgical energy may be applied through the tissue to halt or prevent bleeding. Traditionally, forceps are used to create a single seal per application of electrosurgical energy. Additional seals are made by moving/manipulating the forceps to a second sealing site and applying more electrosurgical energy. For example, when vessels need to be sealed and cut, a surgeon typically makes two seals and cuts between the seals or the surgeon makes three seals and cuts along the centerline of the middle seal. To make these two or three seals, the surgeon manipulates the forceps two or three times and applies electrosurgical energy after each manipulation. This process can be time consuming especially when cutting multiple vessels.

Other methods of the present disclosure include selectively activating additional electrodes on additional prongs of the first and second jaw members to create multiple seals without manipulating the forceps.

As such, Ryan is completely unrelated to the teaching of Schoolman, and there is no motivation to selectively combine certain element(s) in the Ryan device with the Schoolman device in order to obtain the claimed subject matter of the subject application. As such, there is no motivation to combine Ryan with Schoolman, even less, to combine certain selected element(s) from Ryan with

those of Schoolman. Because either of the prior art relied on by the Examiner fails to disclose or suggest any motivation for, or desirability of, the limitations as recited in claims 1 and 29, Applicant submits that modifying the prior art without relying on a teaching or suggestion from the prior art is impermissible hindsight. For at least the foregoing reasons, Applicant respectfully submits that a prima facie case for the § 103 rejection has not been established, and requests that the § 103 rejection for claims 1 and 29 be withdrawn.

Claims 19 and 34

Claim 19 recites a first jaw and a second jaw, wherein *the second jaw remains approximately parallel to the first jaw as the second jaw is moved relative to the first jaw*. Claim 34 recites a similar limitation. Schoolman, Ryan, and their combination do not disclose or suggest such limitation. Rather, Schoolman and Ryan each discloses a device having a first jaw and a second jaw, wherein the second jaw is rotatably coupled to the first jaw at one end. As such, the second jaw forms an angle with the first jaw, and does not remain approximately parallel to the first jaw as the second jaw is moved relative to the first jaw (see Figure 4 of Schoolman, and Figure 1C of Ryan). For at least the foregoing reason, claims 19 and 34, and their respective dependent claims, are believed allowable over Schoolman, Ryan, and their combination.

Claims 40-45

New dependent claims 40-43 are believed allowable for at least the reason that none of the cited references, either alone or in combination, discloses or suggests a first jaw that is *linearly translatable* relative to a second jaw. Also, new dependent claims 44 and 45 are believed allowable for at least the reason that none of the cited references, either alone or in combination, discloses or suggests the steps recited in these claims.


CONCLUSION

Based on the foregoing, all remaining claims are believed in condition for allowance. If the Examiner has any questions or comments regarding this amendment, please contact the undersigned at the number listed below.

Respectfully submitted,

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AMENDMENT TO THE DRAWING FIGURE

Please replace drawing sheet no. 6 (showing figure 7) with the substitute sheet enclosed.